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THE PROCTER & GAMBLE COMPANY
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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,001

Applicant(s)

HUGHES ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-14, 15-26, 76 in the reply filed on 1/31/2005 is acknowledged. Claims 27-75, 77 are canceled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-14 (method) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-14 are directed to "A method of developing a technical standard", which is not within one of the classes of invention set forth in § 101.

The "method of developing a technical standard" comprising the steps of:

- (a) generating a draft ... ;
- (b) electronically circulating the draft ... ;
- (c) automatically attaching review ;
- (d) electronically locking ... ;
- (e) electronically circulating ...;
- (f) collecting electronic approvals ;
- (g) rendering the technical standard unchangeable ...;

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(f) releasing the ... standard for electronic access.”

, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “method of obtaining knowledge about an enterprises data” comprising the steps of (a)-(f) as shown are:

1) merely an abstract idea and

2) does not reduce to a practical application in the technological arts (integration with computer/ computer network to produce an output result) and are therefore are found to be non-statutory.

See (1) *In re Schrader*, 22 F.3d 290, 30 USPQ2d 1455 (CCPA 1994), (2) *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, (3) *In re Waldbaum*, 173 USPQ 430 (CCPA 1972), (4) *In re Musgrave*, 167 USPQ 280 (CCPA 1970), and (5) *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 112

4. **Claims 1-14, 15-26, 76 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.**

There are 2 issues:

1) The term “a text-based document containing information relating to the draft technical standard” or “technical document” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

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In claims 1, 15, and 76 above, it's not clear how steps (b), (c), (d), (e), (f), (g) and (h) are carried out. A review of the specification, page 9, lines 28-29, indicates that for (b): "*the technical **document** is automatically routed to the peer review group for examination*" which shows that a document is routed or in other word, steps (b)-(h) are carried out on a electronic document and not on an information or data. Similarly, on page 11, lines 5-7, which discloses the locking of the document by locking the entry to the document since one cannot lock the specification. Moreover, as shown in the specification, applicant has shown only one way of circulating the document or locking the document. No disclosure of how to circulate the information/specification (standard) or locking the information/specification (standard) has been shown. Therefore, the broad claim language in these three set of independent claims have no support.

2) As shown in the "Background Art" and well known conventional practices for creating a standard specification for reviewing and approval, a step of editing the draft document by amending, revising, modifying, adding and/or deleting the draft context to desired standard prior to approval is critical to achieve the scope of the claimed invention; however, this step is not cited in all the claims. Note that in the specification, applicant mentions the term "modifying an existing standard" on page 1, line 15. It's very rare that a draft copy which is circulated through 2 groups, a reviewing group and approval group, but has no revision, modification, etc.

5. Claims 1-14, 15-26, 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1-14 (method), 15-26 (system), and 76 (product) call for a method, system, and computer-readable media having computer-readable instructions respectively for developing a technical standard in the process of product development comprising:

- (a) generating a draft technical standard (specification);
- (b) electronically circulating the draft technical standard (specification) to a review group.
- (c) automatically attaching comments (information) to the draft technical standard (specification) ;
- (d) electronically locking the standard (specification);
- (e) electronically circulating the standard (specification);
- (f) collecting electronic approvals ;
- (g) rendering the technical standard (specification) unchangeable; and
- (h) releasing the rendered technical standard (specification) for electronic access", this is vague and confusing because, the standard is merely an information or data, i.e. product specification, see specification, page 1, line 11 "*standards (sometimes called specifications)*", or F.P. Pad weight 0.10, (see Fig. 8) and not an object, i.e. document or page or memo which can be circulated, edited, and access. From the specification, it appears that the scope of the invention deals with editing and circulating an electronic draft document containing the draft technical standard information or electronically capturing a text-based document containing the information related to the draft technical standard.

In claims 1, 15, and 76 above, it's not clear how steps (b), (c), (d), (e), (f), (g) and (h) are carried out. A review of the specification, page 9, lines 28-29, indicates that for (b): "*the technical **document** is automatically routed to the peer review group for examination*" which shows that a document is routed or in other word, steps (b)-(h) are carried out on a electronic document and not on an information or data. Similarly, on page 11, lines 5-7, which discloses the locking of the document by locking the entry to the document since one cannot lock the specification.

In claims 1, 15, and 76 above, it's not clear how one can edit/review the draft document which normally requires changing or deleting or adding materials or content materials if the 3rd step requires "electronically locking the draft copy" or in other word, no change is allowed after the comments are attached. There is no citation for "editing or changing the content of the draft technical standard" in the body of the claim. See US Patent 5,040,142, col. 2, and 4 cited below.

In claims 1 and 76, steps (f) and (g) are vague and indefinite because the approvals should come from each member of the approval group² and not the review group¹.

In claim 15, step (f), the phrase "the released approved technical standard" lacks antecedent basis.

Claim Objections

6. Claims 2-3 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

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in proper dependent form, or rewrite the claim(s) in independent form. Current claim 1, step (a) deals with generating a draft technical specification (or data) called standard. Dep. claim 2 deals with capturing a text-based document electronically. It's not clear how a physical item (document) further limits an abstract idea or data (numbers or words).

In dep. claim 3, it's not clear how the "searching the standard" based on the data-structured attributes further limit claim 2?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 15-26, 76 are rejected under 35 U.S.C. 102(b) as being anticipated by LEMBLE (US patent 5,315,504).**

As for independent apparatus claim 15, LEMBLE discloses a computer network system {see Fig. 1 or 2} comprising:

- (a) a database (Fig. 4, 5 "Data Base"),
- (b) module (program) in communication with the database {see Fig. 5, or 6}, and
- (c) module (program) in communication with plurality of users {see Figs. 5 or 6 or 4, or cols. 3-4}.

As for the remaining language, the interface module operative to (a)-(f), these carry no patentable weight since a module is merely a program and it's incapable of carrying out the claimed steps without connecting to a "server system" wherein the server system comprising (a) processor, (b) database and (c) a memory for storing a program, and wherein the processor is operative with the program to: (a)-(f). Therefore, it's recommended that the current claim to be amended to include the language of the "server system" indicated above.

As for dep. claims 16-26 (part of 15), they are rejected for the same reason set forth in claim 15 above since no server system or connection to a server system to carry out the steps are claimed.

As for independent product claim 76, it's rejected over the computer-readable media (program) to carry out the invention of LEMBLE above {see Figs. 5, 18}. As for the limitations of the to (a)-(f), these carry no patentable weight since a media is merely a program and it's incapable of carrying out the claimed steps without connecting to a "server system" wherein the server system comprising (a) processor, (b) database and (c) a memory for storing a program, and wherein the processor is operative with the program to: (a)-(f). Therefore, it's recommended that the current claim to be amended to include the language of the "server system" indicated above.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 1-14, 15-26, 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of GRAINGER (us 2002/0111824).**

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As for independent method¹ claim 1, AAPA, as shown on pages 1-2 of the specification, "Background Art", fairly discloses a method of developing a technical standard in the process of product development comprising:

- (a) generating a draft technical standard (specification);
- (b) electronically circulating the draft technical standard (specification) to a review group.
- (c) electronically attaching comments (information) to the draft technical standard (specification) from the reviewing group;
- (e) electronically circulating the standard (specification);
- (f) collecting electronic approvals from each member of the approval group, and
- (h) releasing the rendered technical standard (specification) for electronic access.

AAPA fairly teaches the claimed invention except for steps:

- (d) electronically locking the standard (specification); and
- (g) rendering the technical standard (specification) unchangeable once each member of the approval group has electronically approved.

In another similar process for managing electronic documents related to application such as reviewing a draft application by generating the draft application, circulating the draft for reviewing and editing, adding comments to the draft, editing the draft, and coordinating, tracking, and approving the draft document, [see 0015, 0016, 0026-0039], GRAINGER discloses the use of Internet or web pages for global access

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for circulation of draft document for review and comment comprising the steps of: (d) electronically locking the document; and

(g) rendering document unchangeable once each member of the approval group has electronically approved in order to prevent subsequent alterations as well as an MIS log functions that generates an "audit trail" {see 0070, 0130}}. Note that GRAINGER cites the managing of a draft application dealt with patent application, however, as shown on [0146], GRAINGER indicates the other embodiments as well as alternatives or similar draft application document management, would have been obvious to a skilled artisan. Therefore, it would have been obvious to modify the managing document of AAPA by using a better managing document as taught by GRAINGER using the Internet/web page design for global access, automation, coordinating and tracking the process [0029-0036] and further including the two steps of GRAINGER cited above for the benefits of preventing subsequent alterations or providing MIS log functions that generates an "audit trail" {see 0070, 0130}}.

As for dep. claim 2 (part of 1), which deals with draft generating parameters, i.e. text-based document being captured electronically, this is taught in AAPA page 2, 1st paragraph, see "computer automation, document development, electronic distribution". Moreover, this is also taught in GRAINGER [0048, or 0027].

As for dep. claim 3 (part of 1), which deals with draft generating parameters, i.e. searching it using other data-structured attributes, this is fairly taught in AAPA, page 1, lines 14-15 wherein "this draft is created by modifying an existing standard" which normally requires or inherently includes some searching using similar data attributes.

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Moreover, this is non-essential to the scope of the claimed invention which deals with reviewing and approving the draft electronically, and is fairly taught in GRAINGER [0071].

As for dep. claim 4 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. tracking status of reviewing and approval, this is fairly taught in GRAINGER in [0010, 0052, 0067, 69] and in view of AAPA/GRAINGER. The selection of other desired or similar variables for tracking is within the skill of the artisan.

As for dep. claim 5 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. electronically notifying specified user upon approval, this is fairly taught in AAPA page 1, lines 16-17, page 2, lines 3-4, or GRAINGER on [0038, 0096, 0130].

As for dep. claim 6 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. storing the standard in a globally accessible database, this is taught in GRAINGER on Fig. 2, 100, 101, 102, 106 (database).

As for dep. claims 7-9 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. limiting access of the standard based on user authorization and approval, these are fairly taught in GRAINGER on [0061, 0129, 0142].

As for dep. claim 10 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. modifying, incrementing new version, circulating, etc., these are fairly taught in GRAINGER on [0129-0130 "new version"].

As for dep. claim 11 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. translating the standard to proper language for reviewing and

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communication, is non-essential to the scope of the claimed invention which deals with reviewing and approving the draft electronically and would have been obvious to a skilled artisan as routine works to convert the language of the draft to appropriate language for reviewing and approving by the groups.

As for dep. claim 12 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. attaching additional reviewing and commenting information in the form of documentations or other, this is fairly taught by GRAINGER on Fig. 6, 254, 256, or [0061].

As for dep. claim 13 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. printing the approved document with watermark including the printing date, this is non-essential to the scope of the claimed invention which deals with reviewing and approving the draft electronically, and is fairly taught by AAPA on page 1, lines 15-17. Moreover, it would have been obvious to a skilled artisan to do so if printed document or paper with effective date of approved is desired.

As for dep. claim 14 (part of 1), which deals with well known draft reviewing and approving parameters, i.e. storing the approved document, this is fairly taught by GRAINGER on Fig. 2, 100, or [0042, 0130].

As for independent apparatus¹ claim 15, which is the apparatus to carry out the scope of method claim 1 above, it's rejected over the elements to carry out the method steps of claim 1 as cited above or over the same rejections using AAPA in view of GRAINGER as cited in claim 1 above.

As for dep. claim 16 (part of 15), which deals with draft generating parameters, i.e. by copying existing/approved standard, this is taught in AAPA/GRAINER in view of the teaching of AAPA on page 1, lines 15 "may be created or formed by modifying an existing standard" which normally requires a copying step followed by modifying step. The setting up of sufficient database and module to carry out these steps are within the skilled artisan and would have been obvious.

As for dep. claims 17-26 (part of 15), which have the same limitations as in dep. claims 2, 3, 5, 7, 8, 9, 10, 11, 12 and 13 respectively, they are rejected for the same reasons set forth in dep. claims 2, 3, 5, 7, 8, 9, 10, 11, 12 and 13 above.

As for independent product¹ claim 76, which is the computer-readable media having computer-readable instructions for performing the method of claim 1 above, it's rejected over the computer-readable media of AAPA in view of GRAINGER for performing the method as cited in claim 1 above.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent 5,315,504 with the title "Electronic document approval system".

Note the term "document" is used.

2) US Patent 5,040,142 with the title "Method of editing and circulating an electronic draft document amongst retrieving persons at remote terminals

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attached to a local area network". Note again the term "draft document" is used not just "draft technical standard" as in the claimed invention.

3) US 2002/0069099 with claim 1 of:

"(a) preparing a plurality of test plan review documents".

Note the term "document" is used again.

Therefore, applicant is recommended to include the term "document" in the independent claims (preamble and step (a)) to clarify the invention and overcome the rejections.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 2, 2005



DEANT. NGUYEN
PRIMARY EXAMINER